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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Michael Costonis et al.

Appln. No.: 09/559,725

Filed: April 28, 2000

For: CLAIMS DATA ANALYSIS TOOLKIT

Examiner: Frenel, Vanel

Art Unit: 3626

Attorney Docket No: 10022/223

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

## TRANSMITTAL

Sir:

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					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+ \$360=	
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Respectfully submitted,

John C. Freeman, Esq. (Reg. No. 34,483)

October 2, 2006

Date

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HOFFER  
GILSON  
& LIONEBRINKS HOFFER GILSON & LIONE  
NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

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Our Case No. 10022/223

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Michael Costonis et al.	)	
	)	Examiner: Frenel, Vanel
Serial No. 09/559,725	)	
	)	Group Art Unit No. 3626
Filing Date: April 28, 2000	)	
	)	
For CLAIMS DATA ANALYSIS	)	
TOOLKIT	)	

**APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is in response to the Office Action mailed June 15, 2006<sup>1</sup>.

10/05/2006 HDEMESS1 00000035 09559725

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<sup>1</sup> Appellants filed a Notice of Appeal on September 15, 2006. Since the Notice of Appeal was filed within three months of the mailing date of the Office Action and the present Appeal Brief is being filed within two months of the filing of the Notice of Appeal, the present Appeal Brief is timely filed. While the Office Action was not made Final, the present Appeal is allowed under 37 CFR § 41.31(a) in view of the fact that the claims have been twice rejected.

**I. REAL PARTY IN INTEREST**

Accenture L.L.P. is the real party of interest in this Appeal pursuant to: 1) a recorded assignment of the application to Andersen Consulting executed by the inventors and 2) a recorded change of name of Andersen Consulting to Accenture L.L.P.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals, interferences or other judicial proceedings that may be related to, would directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

**III. STATUS OF CLAIMS**

Claims 1-108, all claims presented, are rejected. No claims are allowed, withdrawn, objected to or canceled.

**IV. STATUS OF AMENDMENTS**

An Amendment was filed on October 13, 2003 regarding a Final Office Action mailed on May 15, 2003. A Request for Continued Examination was filed concurrently with the October 13th Amendment and so the October 13, 2003 Amendment has been entered. An Amendment was filed on April 29, 2005 regarding a Final Office Action mailed on January 31, 2005. The April 29th Amendment was not entered per an Advisory Action mailed on May 13, 2005. An Amendment was filed on May 31, 2005 regarding the January 31st Final Office

Action. A Request for Continued Examination was filed concurrently with the May 31st Amendment and so the May 31, 2005 Amendment has been entered. There have been no subsequent amendments.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

An understanding of the invention of independent claims 1, 28, 55 and 82 can be made upon a review of the embodiments of the invention shown in Figs. 1, 3, 4, 7 and 8 of the specification. Note that in the description to follow, like elements will employ identical identification numerals.

Fig. 1 shows an embodiment of a system that includes an input device 2, display 4 and a computer 6 which includes a memory S and a central processing unit 10 (P. 4, ll. 19-20). The system may be implemented in a distributed system containing a server computer and client computers (P. 4, l. 20 – P. 5, l. 2). As shown in Fig. 3, the CDA toolkit 300 includes five segments: setup 310, file entry 320, review 330, analysis 340 and information 350 (P. 5, ll. 6-7). These segments can be visually represented in the form of menus wherein a user can select different options from different menus (P. 5, ll. 7-9). For example, from a menu in the CDA toolkit, the user can select the setup 310 menu, file entry 320 menu, review 330 menu, analysis 340 menu or information 350 menu (P. 5, ll. 9-10). Any reference to segment herein can be represented on a display as any type of menu (P. 5, l. 11). The first segment, set up 310, provides for initial data entry and allows a reviewer or

a user or administrator of the system to initialize the database in order to prepare for claim reviews (P. 5, ll. 11-13). The second segment, file entry 320, allows a reviewer or administrator to capture and view the relevant information connected with requested and received claim files (P. 5, ll. 14-15). The third segment, review 330, allows a reviewer or administrator to access and input information regarding ongoing claim file reviews (P. 5, ll. 15-17).

As shown in Fig. 4, setup 310 is broken down into five segments: Setup 310 allows a reviewer or administrator to initialize the database in order to prepare for completing claimfile reviews (P. 6, ll. 4-6). Best practice information 430 allows a reviewer or administrator to enter best practices (BP) identification information which is to be used in the claims data analysis to capture the loss economic opportunity (P. 7, ll. 3-5). It can be appreciated by one of ordinary skill in the art that the reviewer can select from a standard set of best practices provided for the automobile, liability, property and accident lines of business, or the reviewer can create his own best practices (P. 7, ll. 5-8). Examples of best practices that can be selected and their characteristics are shown in Table 1 (P. 7, l. 8 – P. 18, l. 4).

As shown in Fig. 7, mentioned best practice 708 is a report that shows the number of times each best practice is mentioned (both for a positive loss economic opportunity and customer service) and the average loss economic opportunity percentage (P. 23, ll. 11-13). The score (count multiplied by average loss economic opportunity) should be used to identify a best practice with significant impact (P. 23,

II. 14-15). The average loss economic opportunity is calculated as the average of all already reviewed files with the specific best practice mentioned (P. 23, II. 15-17).

Best practices with loss economic opportunity 710 is a report that shows for each best practice the number of times the best practice was mentioned where the best practice was related to a positive loss economic opportunity and the average loss economic opportunity percentage for each best practice, differentiating between indemnity and the allocated loss adjustment expense (ALAE) (P. 23, II. 18-21). The score (count multiplied by average loss economic opportunity) is used to identify the best practice with significant impact (P. 23, I. 21 – P. 24, I. 1).

Opportunity projection per best practice 716 is a report which shows a production of the opportunities for each best practice, sorted by the phases of claim handling process (P. 24, II. 17-19). The opportunity is calculated by multiplying the total claim volume with the frequency of loss economic opportunity and the average loss economic opportunity (one loss economic opportunity occurs) for each best practice (P. 25, II. 9-12). This report also provides information regarding the count of mentioning where the best practice was related to a positive loss economic opportunity (P. 25, II. 12-13). This report helps to identify and quantify these best practices with high opportunities (P. 25, II. 13-14).

Fig. 8 depicts a flowchart representing a method of calculating the best practice and the loss economic opportunity (P. 29, II. 5-6). Once the system is calibrated, the user reviews the claims (step 820), and provides responses to the

questionnaires based on his review of the claims (step 830) (P. 29, ll. 10-12). The reviewer then links his or her responses to the questionnaires to specific best practices that were invoked during the claims process and can further be linked to the particular phase the best practice was used (step 840) (P. 29, ll. 12-14). For example, a reviewer can enter information indicating the net loss economic opportunity (LEO) identified in the particular claim file review, a value representing customer service identified in the particular claim file review, a first, second and/or third best practice identified in the particular claim file review, and a best practice weight (0% up to 100%) for which to attribute the customer service and best practices entered to the net LEO (P. 29, ll. 14-19). The system then calculates a loss economic opportunity based on the reviewer's responses to the questionnaires (step 850) (P. 29, ll. 19-20).

After the loss economic opportunity is calculated, the reviewer has an opportunity to generate reports which include statistics on all aspects of claims processing (P. 29, ll. 21-22). These reports include loss economic opportunity and the frequencies of loss economic opportunity for each line of business, frequency of best practices used, account for each best practice representing where the best practice was related to a positive loss economic opportunity and the average loss economic opportunity percentage for each best practice, which best practices are related to customer service, and a projection of the total loss economic opportunity based on the underlying segmentation of the claim files and the claim volume of that

segment (P. 29, I. 22 – P. 30, I. 6). After the reporting step (step 860), best practices and loss for not utilizing best practices are determined (step 870) (P. 30, II. 6-8). For example, a reviewer, in providing responses to a questionnaire may enter data reflecting a net LEO: \$150, customer service value: 1, best practice 1: 17, and %: 100 (P. 30, II. 9-10). Since a net LEO was indicated and best practice 1 was indicated and weighted 100%, this means that for that particular claim, the failure to use best practice 17 cost the insurance company \$150 with a need for customer service (P. 30, II. 10-13).

With the above summary in mind, claim 1 claims the invention as a method for claims data analysis that includes receiving information associated with a plurality of processed claims and providing responses into an electronic data processing system in response to a set of queries associated with the information. An example of such receiving and providing is the computer 6 of Fig. 1 that receives claim information from a reviewer or administrator (P. 5, II. 15-17). Such claim information is used by a user to provide responses to questionnaires per step 830 of Fig. 8 (P. 29, II. 10-12). The claimed method further entails selecting a subset of best practices from a predetermined set of best practices associated with a claims handling process and associating the subset of best practices with the responses. An example of such selecting and associating is performed per step 840 of Fig. 8 (P. 29, II. 12-14). The claimed invention also involves determining with the electronic data processing system a loss economic opportunity associated with processing the



plurality of claims, where the loss economic opportunity includes a cost associated with processing the plurality of claims and is determined based on the responses and identifying from the subset of best practices a best practice associated with processing the plurality of claims based on the loss economic opportunity. An example of such determining and identifying are disclosed at steps 850 and 870 of Fig. 8 (P. 29, ll. 19-20 and P. 30, ll. 6-8 and 10-13).

Claim 28 claims the invention as an apparatus for claims data analysis that includes a receiving module for receiving information associated with a plurality of processed claims and a providing module for providing responses into a data processing system in response to a set of queries associated with the information. An example of such receiving and providing modules is the computer 6 of Fig. 1 that receives claim information from a reviewer or administrator (P. 5, ll. 15-17). Such claim information is used by the computer to provide responses to questionnaires per step 830 of Fig. 8 (P. 29, ll. 10-12). The claimed apparatus further entails a selecting module for selecting a subset of best practices from a predetermined set of best practices associated with a claims handling process and an associating module for associating the subset of best practices with the responses. An example of such selecting and associating modules is within the computer 6 that perform step 840 of Fig. 8 (P. 29, ll. 12-14). The claimed invention also involves a determining module for determining a loss economic opportunity associated with processing the plurality of claims, where the loss economic opportunity includes a cost associated with

processing the plurality of claims and is determined based on the responses and an identifying module for identifying from the subset of best practices a best practice associated with processing the plurality of claims based on the loss economic opportunity. An example of such determining and identifying modules are within the computer that performs the steps 850 and 870 of Fig. 8 (P. 29, ll. 19-20 and P. 30, ll. 6-8 and 10-13).

Claim 65 claims the invention as a computer-readable medium containing executable instructions for claims data analysis that includes executable instructions stored on a computer-readable medium for receiving information associated with a plurality of processed claims and for providing responses into a an electronic data processing system in response to a set of queries associated with the information. An example of such a computer-readable medium is within the computer 6 of Fig. 1 that receives claim information from a reviewer or administrator (P. 5, ll. 15-17). Such claim information is used by a user to provide responses to questionnaires per step 830 of Fig. 8 (P. 29, ll. 10-12). The claimed computer-readable medium further entails including instructions for selecting a subset of best practices from a predetermined set of best practices associated with a claims handling process and for associating the subset of best practices with the responses. An example of such instructions for selecting and associating are represented by step 840 of Fig. 8 (P. 29, ll. 12-14). The claimed invention also involves a computer-readable medium with instructions for determining a loss economic opportunity associated with

processing the plurality of claims, where the loss economic opportunity includes a cost associated with processing the plurality of claims and is determined based on the responses and for identifying from the subset of best practices a best practice associated with processing the plurality of claims based on the loss economic opportunity. An example of such a computer readable medium with instructions for determining and identifying is within the computer 6 with instructions represented by steps 850 and 870 of Fig. 8 (P. 29, ll. 19-20 and P. 30, ll. 6-8 and 10-13).

Claim 82 claims the invention as an electronic data processing system for claims data analysis that includes a means for receiving information associated with a plurality of processed claims and a means for providing responses into the electronic data processing system in response to a set of queries associated with the information. An example of such means is the system that includes computer 6 of Fig. 1 that receives claim information from a reviewer or administrator (P. 5, ll. 15-17). Such claim information is used by the system to provide responses to questionnaires per step 830 of Fig. 8 (P. 29, ll. 10-12). The claimed apparatus further entails a means for selecting at least one subset of best practices from a predetermined set of best practices associated with a claims handling process and a means for associating the subset of best practices with the responses. An example of such means is the system that includes computer 6 of Fig. 1 that perform step 840 of Fig. 8 (P. 29, ll. 12-14). The claimed invention also involves a means for determining with the electronic data processing system a loss economic opportunity

associated with processing the plurality of claims, where the loss economic opportunity includes a cost associated with processing the plurality of claims and is determined based on the responses and a means for identifying from the subset of best practices a best practice associated with processing the plurality of claims based on the loss economic opportunity. An example of such means is within the computer that performs the steps 850 and 870 of Fig. 8 (P. 29, ll. 19-20 and P. 30, ll. 6-8 and 10-13).

There are means-plus-function terms or step-plus-function terms in independent claim 82 and dependent claims 83-104 which are argued separately below in Section VII.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The three rejections presented for review: 1) claims 1-108 as being directed to nonstatutory subject matter under 35 U.S.C. § 101, 2) claims 1-3, 5-23, 27-30, 32-50, 54-57, 59-77, 81-84, 86-104 and 108 as being obvious under 35 U.S.C. § 103(a) in view of Hammond, U.S. Patent No. 5,712,984, Moore et al., U.S. Patent No. 5,930,759, Little et al., U.S. Patent No. 5,359,509 and the untitled article by Ara C. Trembly published on April 20, 1998 in National Underwriter (Property & Casualty/Risk & Benefits Management, Vol. 102, No. 16, page 43 (hereinafter "the Trembly article") and 3) claims 4, 24-26, 31, 51-53, 58, 78-80, 85 and 105-107 as

being obvious under 35 U.S.C. § 103(a) in view of Hammond, Moore et al., Little et al., the Trembly article and Fatseas et al., U.S. Patent No. 5,671,409.

## **VII. ARGUMENT**

### **A. 35 U.S.C. § 101**

#### **1. Claims 1-27**

Claims 1-27 were rejected in the Office Action of June 15, 2006 (hereinafter “the Office Action”) under 35 U.S.C. §101 as being directed to non-statutory subject matter. Appellants traverse the rejection. A new and useful process is statutory subject matter as recited under 35 U.S.C. §101 and claims 1-27 regard such a process. The Office Action has set up a two prong test to determine if the claims are directed to statutory subject matter: 1) whether the invention is within the technology arts and 2) whether the invention produces a useful, concrete, and tangible result. Assuming for argument’s sake that the two prong test is applicable, the invention of claims 1-27 meets both criteria. First, the claimed invention is within the technology art of methods of claims data analysis. Second, the claimed invention determines a loss economic opportunity via an electronic data processing system, wherein the loss economic opportunity is determined by responses provided via the electronic data processing system. Accordingly, the rejection is improper and should be withdrawn.

It is noted that the Office Action asserts that the rejection can be overcome by reciting that the claimed method/process steps are implemented on a computer system or on a computer readable medium. Independent claim 1 recites providing responses into an electronic data processing system and determining with the electronic data processing system a loss economic opportunity. Accordingly, the rejection is improper per the Office Action's own standard.

**2. Claims 28-54**

Claims 28-54 were rejected in the Office Action under 35 U.S.C. §101 as being directed to non-statutory subject matter. Appellants traverse the rejection. A new and useful machine is statutory subject matter as recited under 35 U.S.C. §101 and claims 28-54 regard such a machine. Assuming for argument's sake that the two prong test mentioned above on pages 7 and 8 in Section VII.A.1 is applicable, the invention of claims 28-54 meet both criteria. First, the claimed invention is within the technology art of apparatuses that analyze data. Second, the claimed invention produces the tangible result of identifying a best practice associated with processing a plurality of claims. Accordingly, the rejection is improper and should be withdrawn.

It is noted that the Office Action asserts that the rejection can be overcome by reciting that the claimed method/process steps are implemented on a structure, such as a computer system or on a computer readable medium. Independent claim 28 recites such structure as a receiving module, a providing module, a selecting

module, an associating module, a determining module and an identifying module. Dependent claims 29-50 also recite structure via the recitation of various modules. Accordingly, the rejection is improper per the Office Action's own standard.

**3. Claims 55-81**

Claims 55-81 were rejected in the Office Action under 35 U.S.C. §101 as being directed to non-statutory subject matter. Appellants traverse the rejection. A new and useful machine is statutory subject matter as recited under 35 U.S.C. §101 and claims 55-108 regard such a machine. Assuming for argument's sake that the two prong test mentioned above on pages 7 and 8 in Section VII.A.1 is applicable, the invention of claims 55-108 meet both criteria. First, the claimed invention is within the technology art of computer readable media. Second, the claimed invention produces the tangible result of identifying a best practice associated with processing a plurality of claims. Accordingly, the rejection is improper and should be withdrawn.

It is noted that the Office Action asserts that the rejection can be overcome by reciting that the claimed method/process steps are implemented on a computer system or on a computer readable medium. Independent claim 55 recites a computer readable medium containing executable instructions. Accordingly, the rejection is improper per the Office Action's own standard.

**4. Claims 82-108**

Claims 82-108 were rejected in the Office Action under 35 U.S.C. §101 as being directed to non-statutory subject matter. Appellants traverse the rejection. A new and useful machine is statutory subject matter as recited under 35 U.S.C. §101 and claims 82-108 regard such a machine. Assuming for argument's sake that the two prong test mentioned above on pages 7 and 8 in Section VII.A.1 is applicable, the invention of claims 82-108 meet both criteria. First, the claimed invention is within the technology art of apparatuses that analyze data. Second, the claimed invention produces the tangible result of identifying a best practice associated with processing a plurality of claims. Accordingly, the rejection is improper and should be withdrawn.

It is noted that the Office Action asserts that the rejection can be overcome by reciting that the claimed method/process steps are implemented on a structure, such as a computer system or on a computer readable medium. Independent claim 82 recites such structure as a receiving means, a providing means, a selecting means, an associating means, a determining means and an identifying means. Dependent claims 83-104 also recite structure via the recitation of various means. Accordingly, the rejection is improper per the Office Action's own standard.



**B. 35 U.S.C. § 103**

**1. Hammond, Moore et al., Little et al. and the Trembly Article**

**a. Claims 1, 3, 12-18 and 27**

Claims 1, 3, 12-18 and 27 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection. In particular, independent claim 1 recites "selecting a subset of best practices from a predetermined set of best practices associated with a claims handling process." The Office Action has conceded that Hammond, Moore et al. and Little et al. do not disclose such "selecting." The Office Action has asserted that the Trembly article discloses the recited "selecting." The text passage of the Trembly article states:

SAP AG, a provider of enterprise application software, and Andersen Consulting, a management and technology consulting firm, have joined forces to offer new business solutions, beginning with a property-casualty claims processing application, a joint announcement said.

According to the announcement, solutions developed under the strategic alliance will "enable insurers and banking institutions to measurably improve business performance."

Predicted improvements are in operational processes, customer service and return on information technology investments, the companies said.

The new property-casualty application will focus on claims processing, "an area that represents more than

80 percent of a p-c insurer's cost of doing business," the announcement stated.

This solution will be based on the SAP Business Framework and Andersen Consulting's claims design, which embodies the firm's vision of future \*\*\*best\*\*\* practices\*\*\*.

John Macdonald, industry marketing manager, financial services, for London-based SAP, called the new property-casualty application a "platform-independent" solution involving three-tier, client server architecture. The solution will be designed to increase productivity by enabling companies to classify claims more accurately and to assign critical claims to the most experienced adjusters, the companies said.

The new property-casualty application will be customized by SAP to work with an insurer's legacy systems by creating interfaces, Mr. Macdonald explained.

The solution is targeted for use by insurance companies, "but it could be customized for agents and brokers," he said.

All parts of the new application will be Year 2000-compliant, he noted, adding that European Economic & Monetary Unit (EMU) compatibility will also be supported.

According to the companies, the application "is intended to enable insurers to improve loss adjustment expenses by 20 percent to 40 percent while reducing money paid out on claims by an estimated three to five percentage points."

The above passage only refers to "best practices" in the section "[t]his solution will be based on the SAP Business Framework and Andersen Consulting's claims

design, which embodies the firm's vision of future \*\*\*best\*\*\* \*\*\*practices\*\*\*.”

Nowhere does the passage mention selecting a subset of best practices in the manner recited in claim 1. Accordingly, the rejection is improper and should be withdrawn.

The rejection of claim 1 is improper for the additional reason that there is no suggestion to alter Hammond et al. to use the recited “associating,” “determining,” and “identifying” processes. The Office Action has conceded that Hammond, Moore et al. and Little et al. do not disclose such “associating,” “determining,” and “identifying” processes. Again, the Office Action has asserted that the Trembly article discloses the recited “associating,” “determining,” and “identifying” processes. However, a review of the text passage of the Trembly article given above reveals that the recited “associating,” “determining,” and “identifying” processes are not present or suggested. Accordingly, the rejection is improper and should be withdrawn.

For the above reasons, the rejection of claim 1 is improper and should be withdrawn. Claims 3, 12-18 and 27 depend directly or indirectly on claim 1 and so their rejections should be withdrawn for the same reasons stated above with respect to claim 1.

**b. Claim 2**

Claim 2 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 2 depends directly on claim 1 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to quantify a best practice in terms of an economic effect in reduction of a cost associated with processing a plurality of claims. The Office Action has conceded that Hammond does not perform the recited quantifying a best practice. The Office Action has relied on a passage at column 9, lines 42-61 of Little et al. as suggesting having Hammond perform the recited quantifying a best practice. The passage of Little et al. is silent as to quantifying a best practice. Since Moore et al. and the Trembly article also do not suggest altering Hammond to perform the recited quantifying a best practice, the rejection is improper and should be withdrawn.

**c. Claims 5 and 19-23**

Claims 5 and 19-23 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly

article. Appellants traverse the rejection for several reasons. First, claims 5 and 19-23 depend indirectly on claim 1 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

Regarding claim 5, its rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to designate at least one best practice and designating a weight for the one best practice applied to each of the plurality of claims as recited in claim 5. The Office Action has conceded that Hammond does not perform the recited designate at least one best practice and designating a weight for the one best practice applied to each of the plurality of claims as recited in claim 5. The Office Action has relied on passages at column 7, lines 31-37 of Little et al. and column 2, lines 52-57, column 9, lines 42-61 and column 10, line 49 to column 11, line 7 of Moore et al. as suggesting having Hammond perform the recited designating at least one best practice and designating a weight for the one best practice applied to each of the plurality of claims as recited in claim 5. The passages of Little et al. and Moore et al. are silent as to designating at least one best practice and designating a weight for the one best practice applied to each of the plurality of claims as recited in claim 5. Since the Trembly article also does not suggest altering Hammond to perform the recited designating at least one best practice and designating a weight for the one

best practice applied to each of the plurality of claims, the rejection of claim 5 is improper and should be withdrawn.

Claims 19-23 depend directly on claim 5 and so their rejections should be withdrawn for the same reasons stated above with respect to claim 5.

**d. Claims 6 and 7**

Claims 6 and 7 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 6 and 7 depend directly or indirectly on claim 1 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

Regarding claim 6, its rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to determine an actual cost for processing each claim and evaluate a loss economic opportunity as a percentage of an absolute loss economic opportunity divided by a total claim cost. The Office Action has asserted that Hammond performs the recited determining an actual cost and evaluating a loss economic opportunity per column 6, lines 17-25 and 39-43 and column 15, lines 63-65 of Hammond. The passages of Hammond are silent as to the recited determining and evaluating as recited in claim 6. Since Moore et al., Little et al. and the Trembly article also do not suggest

altering Hammond to perform the recited determining an actual cost and evaluating a loss economic opportunity, the rejection of claim 6 is improper and should be withdrawn.

Claim 7 depends directly on claim 6 and so its rejection should be withdrawn for the same reasons stated above with respect to claim 6.

e. **Claim 8**

Claim 8 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 8 depends indirectly on claim 1 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to calculate a loss economic opportunity for a plurality of claims by averaging a loss economic opportunity for each claim. The Office Action has asserted that Hammond performs the recited calculating a loss economic opportunity per column 20, lines 2-67 of Hammond. The passage of Hammond is silent as to the recited calculating as recited in claim 8. Since Moore et al., Little et al. and the Trembly article also do not

suggest altering Hammond to perform the recited calculating a loss economic opportunity, the rejection of claim 8 is improper and should be withdrawn.

**f. Claim 9**

Claim 9 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 9 depends directly on claim 1 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to generate a report indicating one of office organization, efficiency of processing claims and statistics on processing of claims. The Office Action has asserted that Hammond performs the recited generating a report per column 10, lines 6-23 and column 19, lines 49-64 of Hammond. The passages of Hammond are silent as to the recited generating a report as recited in claim 9. Since Moore et al., Little et al. and the Trembly article also do not suggest altering Hammond to perform the recited generating a report, the rejection of claim 9 is improper and should be withdrawn.



**g. Claim 10**

Claim 10 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 10 depends directly on claim 1 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to calculate a number of responses based on applying standard statistical sampling formulae to a plurality of claims. The Office Action has asserted that Hammond performs the recited calculating per column 8, lines 12-25 of Hammond. The passage of Hammond is silent as to the recited calculating as recited in claim 10. Since Moore et al., Little et al. and the Trembly article also do not suggest altering Hammond to perform the recited calculating, the rejection of claim 10 is improper and should be withdrawn.

**h. Claim 11**

Claim 11 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 11 depends

directly on claim 1 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.a. on pages 11-13 above as to why claim 1 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to determine productivity based on a number of a set of queries responded to. The Office Action has asserted that Hammond performs the recited determining productivity per column 2, lines 9-11 and column 4, lines 18-22 of Hammond. The passages of Hammond are silent as to the recited determining as recited in claim 11. Since Moore et al., Little et al. and the Trembly article also do not suggest altering Hammond to perform the recited determining productivity, the rejection of claim 11 is improper and should be withdrawn.

**i. Claims 28, 30, 39-45, 54, 82, 84, 93-99 and 108**

Claims 28, 30, 39-45, 54, 82, 84, 93-99 and 108 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection. In particular, independent claim 28 recites an apparatus for claims analysis that contains modules that perform the “providing”, “selecting”, “associating”, “determining” and “identifying” processes of claim 1. Similarly, independent claim 82 recites “means” for performing the “providing”, “selecting”, “associating”, “determining” and “identifying”

processes of claim 1. Accordingly, Hammond fails to disclose modules or “means” that perform the cited “providing”, “selecting”, “associating”, “determining” and “identifying” processes for reasons similar to those given in Section VII.B.1.a. on pages 11-13 above.

Moore et al., Little et al. and the Trembly article also fail to suggest altering Hammond to use modules or “means” to perform the cited “providing”, “selecting”, “associating”, “determining” and “identifying” processes for reasons similar to those given in Section VII.B.1.a. on pages 11-13 above. Without such suggestion, the rejections of claims 28 and 82 are improper and should be withdrawn.

Claims 30, 39-45, 54, 84, 93-99 and 108 depend directly or indirectly on claim 28 or claim 82 and so their rejections should be withdrawn for the same reasons stated above with respect to claims 28 and 82.

**j. Claims 29 and 83**

Claims 29 and 83 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 29 and 83 depend directly on claims 28 and 82, respectively, and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a module or “means” to quantify a best practice in terms of an economic effect in reduction of a cost associated with processing a plurality of claims. The module and “means” perform the same function as recited in claim 2 and the Office Action is relying on the same arguments presented in Section VII.B.1.b. on pages 13 and 14 above with respect to claim 2 so as to reject claims 29 and 83. Accordingly, the rejections are improper for reasons similar to those given above in Section VII.B.1.b. with respect to claim 2.

**k. Claims 32, 46-50, 86 and 100-104**

Claims 32, 46-50, 86 and 100-104 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 32, 46-50, 86 and 100-104 depend indirectly on either claim 28 or claim 82 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

Regarding claims 32 and 86, their rejections are improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article use a providing module or a “means” to designate at least one

best practice and designating a weight for the one best practice applied to each of the plurality of claims as recited in claims 32 and 86. The module and “means” perform the same function as recited in claim 5 and the Office Action is relying on the same arguments presented in Section VII. B.1.c. on pages 14 and 15 above with respect to claim 5 so as to reject claims 32 and 86. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.c. with respect to claim 5.

Claims 46-50 and 100-104 depend directly on claim 32 or claim 86 and so their rejections should be withdrawn for the same reasons stated above with respect to claims 32 and 86.

**I. Claims 33, 34, 87 and 88**

Claims 33, 34, 87 and 88 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 33, 34, 87 and 88 depend directly or indirectly on claim 28 or claim 82 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

Regarding claims 33 and 87, their rejections are improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or

the Trembly article to use a determining module or a “means” to determine an actual cost for processing each claim and evaluate a loss economic opportunity as a percentage of an absolute loss economic opportunity divided by a total claim cost. The module and “means” performs the same function as recited in claim 6 and the Office Action is relying on the same arguments presented in Section VII.B.1.d. on pages 15 and 16 above with respect to claim 6 so as to reject claims 33 and 87. Accordingly, the rejections are improper for reasons similar to those given above in Section VII.B.1.d. with respect to claim 6.

Claims 34 and 88 depend directly on claims 33 and 87, respectively, and so their rejections should be withdrawn for the same reasons stated above with respect to claims 33 and 87.

**m. Claims 35 and 89**

Claims 35 and 89 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 35 and 89 depend indirectly on claim 28 or claim 82 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

The rejections are improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use an evaluating module or a “means” to calculate a loss economic opportunity for a plurality of claims by averaging a loss economic opportunity for each claim. The module and “means” perform the same function as recited in claim 8 and the Office Action is relying on the same arguments presented in Section VII.B.1.e. on pages 16 and 17 above with respect to claim 8 so as to reject claims 35 and 89. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.e. with respect to claim 8.

**n. Claims 36 and 90**

Claims 36 and 90 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 36 and 90 depend directly on claim 28 or claim 90 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a generating module or a “means” to generate a report indicating one of office

organization, efficiency of processing claims and statistics on processing of claims. The module and “means” perform the same function as recited in claim 9 and the Office Action is relying on the same arguments presented in Section VII.B.1.f. on pages 17 and 18 above with respect to claim 9 so as to reject claims 36 and 90. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.f. with respect to claim 9.

**o. Claims 37 and 91**

Claims 37 and 91 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 37 and 91 depend directly on claim 28 or claim 82 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a providing module or a “means” to calculate a number of responses based on applying standard statistical sampling formulae to a plurality of claims. The module and “means” perform the same function as recited in claim 10 and the Office Action is relying on the same arguments presented in Section VII.B.1.g. on page 18 above



with respect to claim 10 so as to reject claims 37 and 91. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.g with respect to claim 10.

**p. Claims 38 and 92**

Claims 38 and 92 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 38 and 92 depend directly on claim 28 or claim 82 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.i. on pages 19 and 20 above as to why claims 28 and 82 are patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a determining module or a “means” to determine productivity based on a number of a set of queries responded to. The module and “means” perform the same function as recited in claim 11 and the Office Action is relying on the same arguments presented in Section VII.B.1.h. on page 19 above with respect to claim 11 so as to reject claims 38 and 92. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.h. with respect to claim 11.

**q. Claims 55, 57, 66-72 and 81**

Claims 55, 57, 66-72 and 81 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection. In particular, independent claim 55 recites a computer readable medium that contains instructions that include performing the “providing”, “selecting”, “associating”, “determining” and “identifying” processes of claim 1. Accordingly, Hammond fails to disclose modules that perform the cited computer readable medium for reasons similar to those given in Section VII.B.1.a. on pages 11-13 above.

Moore et al., Little et al. and the Trembly article also fail to suggest altering Hammond to use a computer readable medium with instructions to perform the cited “providing”, “selecting”, “associating”, “determining” and “identifying” processes for reasons similar to those given in Section VII.B.1.a. on pages 11-13 above. Without such suggestion, the rejection of claim 55 is improper and should be withdrawn.

Claims 57, 66-72 and 81 depend directly or indirectly on claim 55 and so their rejections should be withdrawn for the same reasons stated above with respect to claim 55.

**r. Claim 56**

Claim 56 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article.

Appellants traverse the rejection for several reasons. First, claim 56 depends directly on claim 55 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a computer readable medium containing instructions to quantify a best practice in terms of an economic effect in reduction of a cost associated with processing a plurality of claims. The medium contains instructions that perform the same function as recited in claim 2 and the Office Action is relying on the same arguments presented in Section VII.B.1.b. on pages 13 and 14 above with respect to claim 2 so as to reject claim 56. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.b. with respect to claim 2.

s. **Claims 59 and 73-77**

Claims 59 and 73-77 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 59 and 73-77 depend indirectly on claim 55 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section

VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

Regarding claim 59, its rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a computer readable medium with instructions to designate at least one best practice and designating a weight for the one best practice applied to each of the plurality of claims as recited in claim 59. The instructions perform the same function as recited in claim 59 and the Office Action is relying on the same arguments presented in Section VII.B.1.c. on pages 14 and 15 above with respect to claim 5 so as to reject claim 59. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.c. with respect to claim 5.

Claims 73-77 depend directly on claim 59 and so their rejections should be withdrawn for the same reasons stated above with respect to claim 59.

**t. Claims 60 and 61**

Claims 60 and 61 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claims 60 and 61 depend directly or indirectly on claim 55 and so are patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given

in Section VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

Regarding claim 60, its rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a computer readable medium with instructions to determine an actual cost for processing each claim and evaluate a loss economic opportunity as a percentage of an absolute loss economic opportunity divided by a total claim cost. The instructions perform the same function as recited in claim 6 and the Office Action is relying on the same arguments presented in Section VII.B.1.d. on pages 15 and 16 above with respect to claim 6 so as to reject claim 60. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.d. with respect to claim 6.

Claim 61 depends directly on claim 60 and so its rejection should be withdrawn for the same reasons stated above with respect to claim 60.

**u. Claim 62**

Claim 62 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 62 depends indirectly on claim 55 and so is patentable over Hammond, Moore et al., Little et al.

and the Trembly article for at least the same reasons given in Section VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a computer readable medium with instructions to calculate a loss economic opportunity for a plurality of claims by averaging a loss economic opportunity for each claim. The instructions perform the same function as recited in claim 8 and the Office Action is relying on the same arguments presented in Section VII.B.1.e. on pages 16 and 17 above with respect to claim 8 so as to reject claim 62. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.e. with respect to claim 8.

v. **Claim 63**

Claim 63 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 63 depends directly on claim 55 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a

computer readable medium with instructions to generate a report indicating one of office organization, efficiency of processing claims and statistics on processing of claims. The instructions perform the same function as recited in claim 9 and the Office Action is relying on the same arguments presented in Section VII.B.1.f. on pages 17 and 18 above with respect to claim 9 so as to reject claim 36. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.f. with respect to claim 9.

w. **Claim 64**

Claim 64 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 64 depends directly on claim 55 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a computer readable medium with instructions to calculate a number of responses based on applying standard statistical sampling formulae to a plurality of claims. The instructions perform the same function as recited in claim 10 and the Office Action is relying on the same arguments presented in Section VII.B.1.g. on page 18

above with respect to claim 10 so as to reject claim 64. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.g. with respect to claim 10.

x. **Claim 65**

Claim 65 was rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al. and the Trembly article. Appellants traverse the rejection for several reasons. First, claim 65 depends directly on claim 55 and so is patentable over Hammond, Moore et al., Little et al. and the Trembly article for at least the same reasons given in Section VII.B.1.q. on pages 26 and 27 above as to why claim 55 is patentable over the references.

The rejection is improper for the additional reason that there is no motivation in any of Hammond, Moore et al., Little et al. or the Trembly article to use a computer readable medium with instructions to determine productivity based on a number of a set of queries responded to. The instructions perform the same function as recited in claim 11 and the Office Action is relying on the same arguments presented in Section VII.B.1.h. on page 19 above with respect to claim 11 so as to reject claim 65. Accordingly, the rejection is improper for reasons similar to those given above in Section VII.B.1.h. with respect to claim 11.



2. **Hammond, Moore et al., Little et al., Trembly and Fatseas et al.**

a. **Claims 4 and 24-26**

Claims 4 and 24-26 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al., the Trembly article and Fatseas et al. Appellants traverse the rejection. Claims 4 and 24-26 depend directly on claim 1. As pointed out in Section VII.B.1.a. on pages 11-13, independent claim 1 recites various “selecting”, “associating,” “determining,” and “identifying” processes. The Office Action has conceded that Hammond, Moore et al. and Little et al. do not disclose such “selecting.” The Office Action has asserted that the Trembly article discloses the recited “selecting”, “associating,” “determining,” and “identifying” processes. However, it has been shown in Section VII.B.1.a. that the Trembly article does not suggest the recited “selecting” “associating,” “determining,” and “identifying” processes. Since Fatseas et al. does not suggest altering Hammond to use the recited “selecting” “associating,” “determining,” and “identifying” processes, the rejection is improper and should be withdrawn.

b. **Claims 31, 51-53, 85 and 105-107**

Claims 31, 51-53, 85 and 105-107 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al., the Trembly article and Fatseas et al.. Appellants traverse the rejection. Claims 31, 51-53, 85 and 105-107 depend directly on claim 28 or claim 82. As pointed out in

Section VII.B.1.i. on pages 19 and 20, independent claims 28 and 82 recite modules or “means” for performing various “selecting”, “associating,” “determining,” and “identifying” processes. The Office Action has conceded that Hammond, Moore et al. and Little et al. do not disclose modules or “means” for performing such “selecting”, “associating,” “determining,” and “identifying” processes. The Office Action has asserted that the Trembly article discloses the recited modules or “means” for performing the “selecting”, “associating,” “determining,” and “identifying” processes. However, it has been shown in Section VII.B.1.i. that the Trembly article does not suggest modules or “means” for performing the recited “selecting” “associating,” “determining,” and “identifying” processes. Since Fatseas et al. does not suggest altering Hammond to use modules or “means” to perform the recited “selecting” “associating,” “determining,” and “identifying” processes, the rejection is improper and should be withdrawn.

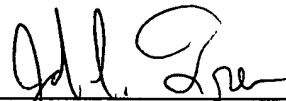
**c. Claims 58 and 78-80**

Claims 58 and 78-80 were rejected in the Office Action under 35 U.S.C. §103 as being obvious in view of Hammond, Moore et al., Little et al., the Trembly article and Fatseas et al. Appellants traverse the rejection. Claims 58 and 78-80 depend directly on claim 55. As pointed out in Section VII.B.1.q. on pages 26 and 27, independent claim 55 recites a computer readable medium having instructions for performing various “selecting”, “associating,” “determining,” and “identifying”

processes. The Office Action has conceded that Hammond, Moore et al. and Little et al. do not disclose such a instructions. The Office Action has asserted that the Trembly article discloses a computer medium that performs the recited "selecting", "associating," "determining," and "identifying" processes. However, it has been shown in Section VII.B.1.q. that the Trembly article does not suggest a computer medium having instructions for performing the recited "selecting" "associating," "determining," and "identifying" processes. Since Fatseas et al. does not suggest altering Hammond to use a computer medium having instructions to perform the recited "selecting" "associating," "determining," and "identifying" processes, the rejection is improper and should be withdrawn.

For the reasons give above, Appellants respectfully submit that the rejections should be withdrawn and the claims should be allowed.

Respectfully submitted,



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John C. Freeman  
Registration No. 34,483  
Attorney for Appellants

BRINKS HOFER  
GILSON & LIONE  
P.O. Box 10395  
Chicago, Illinois 60610  
(312) 321-4200

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**VIII. CLAIMS APPENDIX**

1. A method for claims data analysis, comprising the steps of:  
receiving information associated with a plurality of processed claims;  
providing responses into an electronic data processing system in  
response to a set of queries associated with the information;  
selecting a subset of best practices from a predetermined set of best  
practices associated with a claims handling process;  
associating the subset of best practices with the responses;  
determining with the electronic data processing system a loss  
economic opportunity associated with processing the plurality of claims, where the  
loss economic opportunity includes a cost associated with processing the plurality of  
claims and is determined based on the responses; and  
identifying from the subset of best practices a best practice associated  
with processing the plurality of claims based on the loss economic opportunity.
2. The method of claim 1, wherein determining a best practice further  
includes:  
quantifying the best practice in terms of an economic effect in reduction  
of a cost associated with processing the plurality of claims.
3. The method of claim 1, wherein receiving information further includes:  
providing for at least one query to be completed in response to the  
information associated with each of the plurality of claims.

4. The method of claim 1, wherein providing responses further includes:  
providing the set of queries in more than one language; and  
allowing a user to toggle between queries in different languages.
5. The method of claim 3, wherein providing for at least one query further includes:  
designating at least one best practice used in processing each of the plurality of claims; and  
designating a weight for the one best practice to be applied to each of the plurality of claims.
6. The method of claim 1, wherein determining with the electronic data processing system a loss economic opportunity further includes:  
determining an actual cost for processing each of the plurality of claims; and  
evaluating the loss economic opportunity as a percentage of an absolute loss economic opportunity divided by the total claim cost.
7. The method of claim 6, wherein determining an actual cost further includes:  
calculating the total claim cost as the sum of the indemnity and allocated loss adjustment expense.
8. The method of claim 6, wherein evaluating the loss economic opportunity further includes:

calculating the loss economic opportunity for the plurality of claims by averaging the loss economic opportunity for each of the plurality of claims.

9. The method of claim 1, further including:

generating at least one report indicating one of office organization; efficiency of processing the plurality of claims, and statistics on the processing of the plurality of claims.

10. The method of claim 1, wherein providing responses to a set of queries further includes:

calculating a number of responses to the set of queries to be reviewed based on applying standard statistical sampling formulae to the plurality of claims.

11. The method of claim 1, further including:

determining productivity based on a number of the set of queries responded to.

12. The method of claim 1, further including:

generating a standard report.

13. The method of claim 1, further including:

generating a custom report.

14. The method of claim 1, wherein providing responses to a set of queries further includes:

providing for a standard set of inquiries in the set of queries in an automobile line of insurance.

15. The method of claim 1, wherein providing responses to a set of queries further includes:

providing for a standard set of inquiries in the set of queries in a liability line of insurance.

16. The method of claim 1, wherein providing responses to a set of queries further includes:

providing for a standard set of inquiries in the set of queries in an accident line of insurance.

17. The method of claim 1, wherein providing responses to a set of queries further includes:

providing for a standard set of inquiries in the set of queries in a property line of insurance.

18. The method of claim 1, wherein providing responses to a set of queries further includes:

providing for a standard set of inquiries in the set of queries in a worker's compensation line of insurance.

19. The method of claim 5, wherein providing responses further includes:  
providing for a standard set of best practices in an automobile line of insurance.

20. The method of claim 5, wherein providing responses further includes:

providing for a standard set of best practices in a liability line of insurance.

21. The method of claim 5, wherein providing responses further includes: providing for a standard set of best practices in a property line of insurance.

22. The method of claim 5, wherein providing responses further includes: providing for a standard set of best practices in an accident line of insurance.

23. The method of claim 5, wherein providing responses further includes: providing for a standard set of best practices in a worker's compensation line of insurance.

24. The method of claim 1, wherein the queries are provided in English.

25. The method of claim 1, wherein the queries are provided in German.

26. The method of claim 1, wherein the queries are provided in Dutch.

27. The method of claim 1, wherein the claims are insurance claims.

28. An apparatus for claims data analysis, comprising:  
a receiving module for receiving information associated with a plurality of processed claims;  
a providing module for providing responses into a data processing system in response to a set of queries associated with the information;



a selecting module for selecting at least one subset of best practices from a predetermined set of best practices associated with a claims handling process;

an associating module for associating the subset of best practices with the responses;

a determining module for determining a loss economic opportunity associated with processing the plurality of claims, where the loss economic opportunity includes a cost associated with processing the plurality of claims and is determined based on the responses; and

an identifying module for identifying from the subset of best practices a best practice from the subset of best practices associated with processing the plurality of claims based on the loss economic opportunity.

29. The apparatus of claim 28, wherein the determining module for determining a best practice further includes:

a quantifying module for quantifying the best practice in terms of an economic effect in reduction of a cost associated with processing the plurality of claims.

30. The apparatus of claim 28, wherein the receiving module for receiving information further includes:

a providing module for providing for at least one query to be completed in response to the information associated with each of the plurality of claims.

31. The apparatus of claim 28, wherein the providing module for providing responses further includes:

a providing module for providing the set of queries in more than one language; and

an allowing module for allowing a user to toggle between queries in different languages.

32. The apparatus of claim 30, wherein the providing module for providing for at least one query further includes:

a designating module for designating at least one best practice used in processing each of the plurality of claims; and

a designating module for designating a weight for the one best practice to be applied to each of the plurality of claims.

33. The apparatus of claim 28, wherein the determining module for determining a loss economic opportunity further includes:

a determining module for determining an actual cost for processing each of the plurality of claims; and

an evaluating module for evaluating the loss economic opportunity as a percentage of an absolute loss economic opportunity divided by the total claim cost.

34. The apparatus of claim 33, wherein the determining module for determining an actual cost further includes:

a calculating module for calculating the total claim cost as the sum of the indemnity and allocated loss adjustment expense.

35. The apparatus of claim 33, wherein the evaluating module for evaluating the loss economic opportunity further includes:

a calculating module for calculating the loss economic opportunity for the plurality of claims by averaging the loss economic opportunity for each of the plurality of claims.

36. The apparatus of claim 28, further including:

a generating module for generating at least one report indicating one of office organization, efficiency of processing the plurality of claims, and statistics on the processing of the plurality of claims.

37. The apparatus of claim 28, wherein the providing module for providing responses to a set of queries further includes:

a calculating module for calculating a number of responses to the set of queries to be reviewed based on applying standard statistical sampling formulae to the plurality of claims.

38. The apparatus of claim 28, further including:

a determining module for determining productivity based on a number of the set of queries responded to.

39. The apparatus of claim 28, further including:

a generating module for generating a standard report.

40. The apparatus of claim 28, further including:

a generating module for generating a custom report.

41. The apparatus of claim 28, wherein the providing module for providing responses to a set of queries further includes:

a providing module for providing for a standard set of inquiries in the set of queries in an automobile line of insurance.

42. The apparatus of claim 28, wherein the providing module for providing responses to a set of queries further includes:

a providing module for providing for a standard set of inquiries in the set of queries in a liability line of insurance.

43. The apparatus of claim 28, wherein the providing module for providing responses to a set of queries further includes:

a providing module for providing for a standard set of inquiries in the set of queries in an accident line of insurance.

44. The apparatus of claim 28, wherein the providing module for providing responses to a set of queries further includes:

a providing module for providing for a standard set of inquiries in the set of queries in a property line of insurance.

45. The apparatus of claim 28, wherein the providing module for providing responses to a set of queries further includes:

a providing module for providing for a standard set of inquiries in the set of queries in a worker's compensation line of insurance.

46. The apparatus of claim 32, wherein the providing module for providing responses further includes:

a providing module for providing for a standard set of best practices in an automobile line of insurance.

47. The apparatus of claim 32, wherein the providing module for providing responses further includes:

a providing module for providing for a standard set of best practices in a liability line of insurance.

48. The apparatus of claim 32, wherein the providing module for providing responses further includes:

a providing module for providing for a standard set of best practices in a property line of insurance.

49. The apparatus of claim 32, wherein the providing module for providing responses further includes:

a providing module for providing for a standard set of best practices in an accident line of insurance.

50. The apparatus of claim 32, wherein the providing module for providing responses further includes:

a providing module for providing for a standard set of best practices in a worker's compensation line of insurance.

51. The apparatus of claim 28, wherein the queries are provided in English.

52. The apparatus of claim 28, wherein the queries are provided in German.

53. The apparatus of claim 28, wherein the queries are provided in Dutch.

54. The apparatus of claim 28, wherein the claims are insurance claims.

55. A computer-readable medium containing executable instructions for claims data analysis, comprising:

executable instructions stored on a computer-readable medium for receiving information associated with a plurality of processed claims;

executable instructions stored on a computer-readable medium for providing responses into a data processing system in response to a set of queries associated with the information;

executable instructions stored on a computer-readable medium for selecting at least one subset of best practices from a predetermined set of best practices associated with a claims handling process;

executable instructions stored on a computer-readable medium for associating the subset of best practices with the responses;

executable instructions stored on a computer-readable medium for determining a loss economic opportunity associated with processing the plurality of claims, where the loss economic opportunity includes a cost associated with processing the plurality of claims and is determined based on the responses; and

executable instructions stored on a computer-readable medium for identifying from the subset of best practices a best practice associated with processing the plurality of claims based on the loss economic opportunity.

56. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for determining a best practice further includes:

executable instructions stored on a computer-readable medium for quantifying the best practice in terms of an economic effect in reduction of a cost associated with processing the plurality of claims.

57. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for receiving information further includes:

executable instructions stored on a computer-readable medium for providing for at least one query to be completed in response to the information associated with each of the plurality of claims.

58. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses further includes:

executable instructions stored on a computer-readable medium for providing the set of queries in more than one language; and

executable instructions stored on a computer-readable medium for allowing a user to toggle between queries in different languages.

59. The computer-readable medium of claim 57, wherein the executable instructions stored on a computer-readable medium for providing for at least one query further includes:

executable instructions stored on a computer-readable medium for designating at least one best practice used in processing each of the plurality of claims; and

executable instructions stored on a computer-readable medium for designating a weight for the one best practice to be applied to each of the plurality of claims.

60. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for determining a loss economic opportunity further includes:

executable instructions stored on a computer-readable medium for determining an actual cost for processing each of the plurality of claims; and



executable instructions stored on a computer-readable medium for evaluating the loss economic opportunity as a percentage of an absolute loss economic opportunity divided by the total claim cost.

61. The computer-readable medium of claim 60, wherein the executable instructions stored on a computer-readable medium for determining an actual cost further includes:

executable instructions stored on a computer-readable medium for calculating the total claim cost as the sum of the indemnity and allocated loss adjustment expense.

62. The computer-readable medium of claim 60, wherein the executable instructions stored on a computer-readable medium for evaluating the loss economic opportunity further includes:

executable instructions stored on a computer-readable medium for calculating the loss economic opportunity for the plurality of claims by averaging the loss economic opportunity for each of the plurality of claims.

63. The computer-readable medium of claim 55, further including:

executable instructions stored on a computer-readable medium for generating at least one report indicating one of office organization, efficiency of processing the plurality of claims, and statistics on the processing of the plurality of claims.

64. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses to a set of queries further includes:

executable instructions stored on a computer-readable medium for calculating a number of responses to the set of queries to be reviewed based on applying standard statistical sampling formulae to the plurality of claims.

65. The computer-readable medium of claim 55, further including:

executable instructions stored on a computer-readable medium, for determining productivity based on a number of the set of queries responded to.

66. The computer-readable medium of claim 55, further including:

executable instructions stored on a computer-readable medium for generating a standard report.

67. The computer-readable medium of claim 55, further including:

executable instructions stored on a computer-readable medium for generating a custom report.

68. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses to a set of queries further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of inquiries in the set of queries in an automobile line of insurance.

69. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses to a set of queries further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of inquiries in the set of queries in a liability line of insurance.

70. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses to a set of queries further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of inquiries in the set of queries in an accident line of insurance.

71. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses to a set of queries further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of inquiries in the set of queries in a property line of insurance.

72. The computer-readable medium of claim 55, wherein the executable instructions stored on a computer-readable medium for providing responses to a set of queries further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of inquiries in the set of queries in a worker's compensation line of insurance.

73. The computer-readable medium of claim 59, wherein the executable instructions stored on a computer-readable medium for providing responses further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of best practices in an automobile line of insurance.

74. The computer-readable medium of claim 59, wherein the executable instructions stored on a computer-readable medium for providing responses further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of best practices in a liability line of insurance.

75. The computer-readable medium of claim 59, wherein the executable instructions stored on a computer-readable medium for providing responses further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of best practices in a property line of insurance.

76. The computer-readable medium of claim 59, wherein the executable instructions stored on a computer-readable medium for providing responses further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of best practices in an accident line of insurance.

77. The computer-readable medium of claim 59, wherein the executable instructions stored on a computer-readable medium for providing responses further includes:

executable instructions stored on a computer-readable medium for providing for a standard set of best practices in a worker's compensation line of insurance.

78. The computer-readable medium of claim 55, wherein the queries are provided in English.

79. The computer-readable medium of claim 55, wherein the queries are provided in German.

80. The computer-readable medium of claim 55, wherein the queries are provided in Dutch.

81. The computer-readable medium of claim 55, wherein the claims are insurance claims.

82. An electronic data processing system for claims data analysis, comprising:

means for receiving information associated with a plurality of processed claims;

means for providing responses into the electronic data processing system in response to a set of queries associated with the information;

means for selecting at least one subset of best practices from a predetermined set of best practices associated with a claims handling process;

means for associating the subset of best practices with the responses;

means for determining with the electronic data processing system a loss economic opportunity associated with processing the plurality of claims, where the loss economic opportunity includes a cost associated with processing the plurality of claims and is determined based on the responses; and

means for identifying from the subset of best practices a best practice associated with processing the plurality of claims based on the loss economic opportunity.

83. The system of claim 82, wherein means for determining a best practice further includes:

means for quantifying the best practice in terms of an economic effect in reduction of a cost associated with processing the plurality of claims.

84. The system of claim 82, wherein means for receiving information further includes:

means for providing for at least one query to be completed in response to the information associated with each of the plurality of claims.

85. The system of claim 82, wherein providing responses further includes:  
means for providing the set of queries in more than one language; and  
means for allowing a user to toggle between queries in different languages.

86. The system of claim 84, wherein means for providing for at least one query further includes:

means for designating at least one best practice used in processing each of the plurality of claims; and

means for designating a weight for the one best practice to be applied to each of the plurality of claims.

87. The system of claim 82, wherein means for determining a loss economic opportunity further includes:

means for determining an actual cost for processing each of the plurality of claims; and

means for evaluating the loss economic opportunity as a percentage of an absolute loss economic opportunity divided by the total claim cost.

88. The system of claim 87, wherein means for determining an actual cost further includes:

means for calculating the total claim cost as the sum of the indemnity and allocated loss adjustment expense.

89. The system of claim 87, wherein means for evaluating the loss economic opportunity further includes:

means for calculating the loss economic opportunity for the plurality of claims by averaging the loss economic opportunity for each of the plurality of claims.

90. The system of claim 82, further including:

means for generating at least one report indicating one of office organization, efficiency of processing the plurality of claims, and statistics on the processing of the plurality of claims.

91. The system of claim 82, wherein means for providing responses to a set of queries further includes:

means for calculating a number of responses to the set of queries to be reviewed based on applying standard statistical sampling formulae to the plurality of claims.

92. The system of claim 82, further including:

means for determining productivity based on a number of the set of queries responded to.

93. The system of claim 82, further including:

means for generating a standard report.

94. The system of claim 82, further including:



means for generating a custom report.

95. The system of claim 82, wherein means for providing responses to a set of queries further includes:

means for providing for a standard set of inquiries in the set of queries in an automobile line of insurance.

96. The system of claim 82, wherein means for providing responses to a set of queries further includes:

means for providing for a standard set of inquiries in the set of queries in a liability line of insurance.

97. The system of claim 82, wherein means for providing responses to a set of queries further includes:

means for providing for a standard set of inquiries in the set of queries in an accident line of insurance.

98. The system of claim 82, wherein means for providing responses to a set of queries further includes:

means for providing for a standard set of inquiries in the set of queries in a property line of insurance.

99. The system of claim 82, wherein means for providing responses to a set of queries further includes:

means for providing for a standard set of inquiries in the set of queries in a worker's compensation line of insurance.

100. The system of claim 86, wherein means for providing responses further includes:

means for providing for a standard set of best practices in an automobile line of insurance.

101. The system of claim 86, wherein means for providing responses further includes:

means for providing for a standard set of best practices in a liability line of insurance.

102. The system of claim 86, wherein means for providing responses further includes:

means for providing for a standard set of best practices in a property line of insurance.

103. The system of claim 86, wherein means for providing responses further includes:

means for providing for a standard set of best practices in an accident line of insurance.

104. The system of claim 86, wherein means for providing responses further includes:

means for providing for a standard set of best practices in a worker's compensation line of insurance.

105. The system of claim 82, wherein the queries are provided in English.

106. The system of claim 82, wherein the queries are provided in German.
107. The system of claim 82, wherein the queries are provided in Dutch.
108. The system of claim 82, wherein the claims are insurance claims.

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**IX. EVIDENCE APPENDIX**

None.

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**X. RELATED PROCEEDINGS APPENDIX**

None.